

REMARKS

As communicated via telephone to the examiner by applicants' representative on July 21, 2005, the use of WO 2004/072378 (WO378) in combination with other prior art references used to reject the pending claims is improper. The pending application has a filing date and the benefit of priority of foreign filing dates that clearly predate the publication of the WO378 application.

The WO378 application has a publication date of February 3, 2004. On the other hand, the pending application was filed in the U.S. on December 28, 2000 and is the national stage application of the PCT application PCT/EP99/04471 which was filed on June 28, 1999. The PCT application has the benefit of priority of German application 198 29 004.7 which was filed on June 29, 1998. From these dates, it is readily apparent that not only does the pending application have the benefit of priority of foreign applications that predate the WO378 application, but the pending application was filed in the U.S. over four years prior to the publication date of the WO378 application.

Accordingly, under no U.S. statute does the WO378 application qualify as a prior art document that may be used in combination with teachings of other prior art references to demonstrate that the claims of the pending application would be obvious to one skilled in the art at the time the invention of the pending application was made.

As a result, withdrawal of the various grounds using the WO378 application for rejecting claims 18, 19, 21-28 and 46 is requested.

In addition, applicants still maintain, as addressed in the reply of April 26, 2005, that the rejection of claims 29-34 as being unpatentable over the combination of the teachings of U.S. patent 5,817,205 (Kaule) and U.S. patent 5,380,695 (Chiang et al.) is improper.

In brief, the Kaule disclosure does not describe protective coatings that include an acrylate system as the sole binder and lacking a filler substance. There

is simply no evidence in the Kaule disclosure or that placed in the Office action that would motivate a skilled artisan to provide a surface coating having these features.

The Chiang et al. disclosure does not disclose a surface coating layer on the basis of an acrylate material which protects the paper layer. Rather, the acrylate layer disclosed by the Chiang et al. disclosure is an adhesive layer that holds together two layers of the ID card. It is not to provide a protective surface coating. Moreover, the Chiang et al. disclosure neither discloses that the adhesive layer contains acrylates as the sole binder, nor that the adhesive layer lacks a filler substance.

In view of these observations, it is readily evident that neither the Kaule disclosure nor the Chiang et al. disclosure provide sufficient teachings that would motivate one skilled the art to provide a surface coating of the type described and required by both claims 29 and 30. Moreover, it is shown by the basic deficiencies of the Chiang et al. disclosure that the proposed combination of the Kaule and Chiang et al. disclosures would not result in the document of value of claim 29 or the method of claim 30. The Chiang et al. disclosure describes an adhesive layer that is not only unsatisfactory for a dirt repellant surface coating, but the acrylate layer teachings of the Chiang et al. disclosure are not even used to provide a surface coating. Instead, the acrylic layer of the Chiang et al. disclosure is provided to adhere two layers of the ID card together.

Therefore, as a result of the contrary teachings of the Chiang et al. disclosure, and the shortcomings of the Kaule disclosure, withdrawal of this rejection is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 18, 19, 21-34 and 46 be allowed and the application be passed to issue.

Application No.: 09/719,559
Examiner: L. Ferguson
Art Unit: 1774

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Date: October 11, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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